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Supreme Court, U. S.
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IN THE

Supreme Court of the United States

October Term, 1972

No. 72-1534

THE D. S. BROWN COMPANY and
DELMONT D. BROWN,
Petitioners,

v.

ACME HIGHWAY PRODUCTS CORPORATION,
Respondent.

RESPONDENT'S BRIEF IN OPPOSITION TO PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SIXTH CIRCUIT

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Respondent opposes Petitioners' request for a Writ of Certiorari to review the decision of the Sixth Circuit Court of Appeals holding that Petitioners' seal constructions were infringements of Respondent's Patent No. 3,179,036. The Court of Appeals had previously held Respondent's patent valid, 431 F.2d 1074, and certiorari was thereafter denied. 401 U.S. 956.

Statement*

The Court of Appeals had previously found Respondent's patent for a road seal to represent a significant improvement over the prior art:

* Respondent's brief does not accept Petitioners' statement and characterization of the record to be devoid of record references as true. However, this does not affect the merits of the petition since the basic facts are set forth in the opinion of the Court of Appeals.

> "A review of the prior art of the industry indicates, however, that the patent in this case represented a significant improvement over the prior art and, as noted in our previous opinion on this case, the District Court described its initial success, as 'an accomplishment hitherto unheard of.' 431 F.2d at 1077." (See A 9)*

The Court found the accused six seal cross-sections shown (A 5) had "substantial identity between the teachings of Appellant's [Respondent's] patent and the accused seals in structure, mode of operation and result to be accomplished" (A 10). Two of the seals, Figures 2 and 3 (A 4), were admittedly infringements. The Court of Appeals accordingly considered the patent claims (A 37) and found that this significant improvement should not be limited to the exact configuration shown in the patent. Petitioners had adopted the essence of the patented invention (A 10).

The Court of Appeals further considered the contentions made by Petitioners that the accused seals did not read on the patented claims finding them to be insubstantial. The Court held that it "must not emphasize form over substance" (A 7).

The Court found that while the accused single or multiple seals (referred to as "bridge" seals) may offer some improvement over the patented seal, Petitioners had adopted the "basic features" of the invention and the "significant contribution made by Appellant's patent" (A 10). Petitioners' expert had so admitted.

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* References are to pages of the Petition (A).

The Court found that there was absolutely no testimony in the record to support the finding that the accused seals did not function by converting verticle forces into lateral forces (A 9).

Reasons for Denying the Writ

This Court had once before denied certiorari with respect to issues involving this patent. The questions presented before the Court which now relate only to infringement, do not involve any erroneous application of Federal law, nor do they raise any new or unsettled point of Federal law

The Court of Appeals correctly applied the law as set forth in *Graver Tank & Mfg. Co., Inc.* v. *Linde Air Products, Co.,* 339 U.S. 605 (1950). The doctrine of equivalents was correctly and traditionally applied by the Court of Appeals. The Court held the patent should not be limited to the *exact* configuration shown in the patent and described in the claim for such would limit it to a "hollow and useless thing", citing *Graver Tank & Mfg. Co., Inc.* v. *Linde Air Products, Co.,* 339 U.S. at 607 (A 10).

Patents which cover meritorious and genuine improvements are not limited to the precise embodiment. In *Continental Paper Bag Company* v. *Eastern Paper Bag Company,* 210 U.S. 405, 418, this Court stated:

> "An inventor must describe what he conceives to be the best mode, but he is not confined to that. If this were not so most patents would be of little worth. The principle of the invention is a unit, and invariably the

> modes of its embodiment in a concrete invention may be numerous and in appearance very different from each other. Robinson on Patents, §485."

The structures of the accused seals are self-evident and there is no factual dispute as to their construction. The question of infringement was basically one of law or a mixed question of law and fact which the Court of Appeals was free to decide. See *Upright, Inc.* v. *Safway Products, Inc.*, 315 F.2d 23, 26-27 (5 Cir. 1965); *American Technical Machinery Corp.* v. *Caparotta*, 339 F.2d 557, 560 (2 Cir. 1964), cert. denied 382 U.S. 842.

The Court of Appeals correctly applied conventional law and the Petition should be denied.

Respectfully submitted,

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